

DOCKET NO: 214946US79PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JEAN-CLAUDE PAILLES, ET AL. : EXAMINER: J. WORJLOH
SERIAL NO: 09/926,360 :
FILED: DECEMBER 11, 2001 : GROUP ART UNIT: 3685
FOR: PAYMENT SYSTEM FOR :
SOFTWARE PROGRAM USE :

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF ANTICIPATION

Applicants submit that the Official Action of March 18, 2008 has failed to provide a *prima facie* case of anticipation with respect to Claims 24-35.

In rejecting pending Claims 24-35, the Office noted that page 4 of the Official Action dated March 18, 2008 that:

Claims 24-35 recite the functional language whereby. These claims have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. Thus, Claims 24-35 are rejected on the same rational as Claim 23 above.

In support of the above position, the Office has cited *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983):

It appears as though the Office is taking the position **THAT THE MERE EXISTENCE OF THE WORD “WHEREBY” IS GROUNDS FOR IGNORING THE ENTIRETY OF THE CLAIM**; Of course *In re Gulack* stands for no such proposition.

The Office explains that the claims have been considered but the language of the claims have been given little patentable weight and, in fact, have been regarded as “intended use language.” In this regard, Applicants direct the Office’s attention to Claim 25 in which the system is recited as **further comprising a remote payment server**. It is unclear if what, if anything, this further system component has to do with “intended use.”

By way of further example, Claim 26 recites a further system component “**secure means**.” This further system component clearly has nothing at all to do with “intended use”.

Additional claims of Claims 24-35 recite various aspects and functionalities of the system as claimed. **The mere occurrence of the terminology “whereby” in the claims certainly does not excuse the Office from examining these claims.**

In this regard, CFR 1.104(c)(2) which states: "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, **must be clearly explained and each rejected claim specified.**"

Furthermore, the MPEP states:

“In order to provide a complete application file history and to enhance the clarity of the prosecution history record, **an examiner must provide** clear explanations of all actions taken by the examiner during prosecution of an application” (See MPEP § 707.07(f) (emphasis added)).

Due to the complete lack of any clear explanation or identification of a particular aspect relied upon in the recited references relative to claims 24-35, Applicants are at a loss

to properly rebut the current final action. The Official Action has not cited any aspect of the Downs reference (the only reference currently utilized in rejecting the claims of record) in rejecting claims 24-35. **Indeed, it does not appear as though Claims 24-35 have been examined.** Therefore, the grounds of the rejection have not been clearly developed to such an extent that the Applicants can readily judge the advisability of a formal appeal.

Accordingly, Applicants respectfully submit that the finality of the Official Action dated March 18, 2008 is premature and prosecution should be reopened.

CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, Applicants respectfully request that prosecution be re-opened as the current grounds of rejection have not been clearly developed to such an extent that the Applicants can readily judge the Examiner's position or the advisability of preparing a traditional Appeal Brief.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number


22850

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 06/04)

SAM/cmc


- Scott A. McKeown
Attorney of Record
Registration No. 42,866